



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants: Robertson, S.

Serial No.: 09/324,601

Title of Invention: System and Method for Providing Electronic Multi-Merchant Gift Certificate and Contribution Brokering Services Over a Distributed Network

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Examiner: Fadok, M.

Attorney Docket No.: ROBERT.P001

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REPLY TO EXAMINER'S ANSWER

Applicant responds to the Examiner's Answer dated 10/5/2006 as follows:

The Examiner continues to overlook the fact that Appellant claims a complete gift certificate and contribution brokering system that stands alone with a direct connection to merchants and beneficiaries, and no necessity for relationship with suppliers of credit card services, while Gillin discloses a system that offers, in substance, nothing more than the sale of a temporary credit card. Appellant finds it difficult to even address the Examiner's answer without repeating the arguments set forth in the original brief and revised supplemental briefs already filed and still not considered by the Examiner. Appellant calls the Board's attention to Appellant's arguments addressing Ground 3 of rejections to be reviewed on appeal (the only rejection made by the Examiner that still remains

CERTIFICATE OF MAILING (37 CFR 1.8A)

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December 5, 2006

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Patrick Dwyer

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at issue¹ in this Appeal), as presented in the Revised Supplemental Brief of Appellant dated August 25, 2006.

Appellant does appreciate that the Examiner has now “mapped” claim elements to the supposed sections or drawings of Gillin that the Examiner believes are relevant. Surprisingly though, the very sections to which the Examiner calls our attention actually point out the absence in Gillin of any disclosure of Appellant’s claim elements. The Examiner has requested Appellant to “fully consider the references in entirety” and Appellant respectfully requests the Board to do the same. The elements of Gift Certificates, a Gift Certificate Authority Site (also a distributed network website), and a relationship between the Gift Certificate Authority Site and every merchant redeeming a gift certificate are central to all of Claims 23 -34. Likewise, a Contribution Authority Site and relationship between the Contribution Authority Site and every beneficiary is central to all of Claims 35 - 37. Gillin fails to make any disclosure or teaching about gift certificates, gift certificate authority sites, contribution authority sites or relationship between the authority sites and merchants or beneficiaries.

Gillin’s system is just what it claims to be in the first line of the abstract, “A method is disclosed involving acquiring a plurality of charge accounts.” (Gillin, Abstract) That’s it. On the other hand, Applicant’s gift certificate system, one that doesn’t distribute credit card accounts, that doesn’t use an established credit card issuing banking system, is an entirely new idea at the time of Appellant’s application. Gillin actually teaches away from such a system, one without conventional credit card usage, and utterly fails to disclose such a system.

In regards to Claim 23, the Examiner asserts that Gillin discloses several of the claim elements in the abstract, but there is no mention in Gillin’s abstract of creating a gift certificate, just credit cards. Gillin speaks only of “acquiring a plurality of charge accounts. The accounts are of a type normally issued with an associated physically producible card.” (Gillin, abstract) There is no mention of a distributed network, no mention of a plurality of merchants, certainly not merchants who all have sites connected to the distributed network, as required in Claim 23. The Examiner says

¹ The Examiner appears to have conceded Appellant’s position on the other issues.

that Gillin's abstract discloses that any merchant can use the system. Not so. Not just any merchant can use Gillin's system. An actual quote from Gillin's abstract reads, “The charge account is usable in the name of the second party at any merchant who is capable of seeking authorization, using an authorization infrastructure, for purchases involving charge accounts for which the physically producible cards are issued...[Emphasis added]”(Gillin, abstract) This is hardly the same as the element “a plurality of merchant sites connected to the distributed network...” recited in Claim 23. Gillin's merchants are restricted to just those merchants that can accept established credit cards; whereas the merchants of Claim 23 are only restricted to those with a site connected to a distributed network. Even currently, and certainly at the time of Applicant's application, these different merchant classes are not synonymous.

Further regarding the Examiner's “mapping” of Claim 23, the most glaring absence in Gillin is Applicant's element in paragraph 4, “a gift certificate authority site connected to the plurality of merchant sites....” Yet the Examiner claims this element is somehow depicted in Figure 1 of Gillin. This figure is described in Columns 7 and 8 of Gillin, yet in the Gillin specification there is no description matching, or even calling to mind, the claimed Gift Certificate Authority Site. There is thus no teaching in Gillin whatever, and certainly not in Gillin Figure 1, of a Gift Certificate Authority Site.

Appellant's application specifies that gift certificates are purchased through the Gift Certificate Authority Site (Appellant's application, Figures 3-6) and that “Merchant sites 60 communicate with the Gift Certificate Authority 80 to authenticate the gift certificates and to redeem the certificates on the user's behalf.” (Appellant's application, Page 10, paragraph 3) Specifics of the workings of the Gift Certificate Authority can also be found on Appellant's application Page 11, paragraph 5:

“Upon the shopper checking out of the merchant's site and redeeming their gift certificate, the merchant site 60 obtains authentication information from the shopper and transmits this information to the Gift Certificate Authority for approval via the Gift Certificate Agent 64. The Gift Certificate Authority 80 then validates this information against the Gift Certificate Database 86. If all optional restrictions placed on the use of the gift certificate are met, the certificate is still current, and the requested amount is less than or equal to the credited amount, then the Gift Certificate Authority 80 sends a successful result code back to the Merchant Site 60.” (Appellant's application Page 11, paragraph 5)

There is no suggestion whatever of this Gift Certificate Authority or Gift Certificate Authority Site in Gillin. If in Gillin's Figure 1 it is "transfer instrument issuer 10" that the Examiner is equating with Applicant's Gift Certificate Authority Site, it should be noted that this element 10 has no relationship with the merchants. There is no connecting step or arrow between element 10, the transfer instrument issuer, and element 60, the merchants. The transfer instrument issuer merely sells existing credit card accounts, not gift certificates, and cannot function as a Gift Certificate Authority Site. The "transfer instrument issuer 10" only sells credit card accounts to a purchaser (not pictured) and notifies a recipient 40.

Also in the rejection of Claim 23, the Examiner claims that Applicant's element "each merchant site running at least one application to provide an online service to users over the distributed network," is disclosed in Gillin, col. 10, lines 36 - 50. A careful reading of Gillin reveals that these lines are only part of a discussion of credit card banking systems that were current at the time of Gillin. These credit card systems were not adapted to process merchant requests about gift certificates. The discussion relates instead to something called CyberCash and begins as follows:

"Because the current banking credit card system is unable to directly handle internet traffic, CyberCash acts as a gatekeeper linking the internet to bank networks (currently Wells Fargo Bank and First of Omaha Merchant Processing) as needed...CyberCash handles credit card, debit card and cash transactions..." (Gillin, Column 10, Lines 24 - 31)

In contrast, Applicant's element requires each merchant running an online store and interacting directly with a Gift Certificate Authority Site. This is not at all the same as a company (described by Gillin) that serves only as the Internet connection for a credit card issuing bank. Such an entity is incapable of performing Gift Certificate Authority Site functions. CyberCash has nothing to do with gift certificates. CyberCash has no contact with a gift certificate purchaser, and no contact with a gift certificate recipient. Gillin's teachings are mired in a traditional banking credit card system, and the Examiner simply declines to note this difference.

The Examiner also says "a gift certificate authority site connected to the plurality of merchant sites, the gift certificate site including a user database and a merchant database, each database containing authentication information as to respective users and merchants [emphasis added]," corresponds to databases described in Gillin, Column 15, line 15 to Column 17, line 9. A careful

examination of the 20 databases described by Gillin (each field outlined in Gillin, Figures 6A, 6A-1, 6A-2, 6B-1, 6B-2, 6B-3, 7A, 7A-1, 7A-2 and 7B) will reveal that none of them have anything to do with merchants; Applicant defines merchants as the sellers of “retail merchandise, as well as digital products and/or informational or subscription-based services or wholesale purchases” (Appellant’s Application, Page 11, Paragraph 2). Gillin neither needs nor suggests any database of merchant information. Such a database would not even be feasible with millions of merchants accepting “Visa, Mastercard, American Express, JCB, Eurocard, etc...”(Gillin, Column 7, Lines 28-29), which pointedly teaches away from needing or developing the kind of robust system and infrastructure disclosed and claimed by Applicant.

Again, regarding paragraph 4 of Claim 23, the Examiner asserts that “a gift certificate database which stores gift certificate data and transaction data related to particular gift certificates [emphasis added],” corresponds to databases described in Gillin, and a Gillin disclosure in column 18, lines 15 - 45. Applicant’s specification makes it clear that the “transaction data” claimed is data from the merchant:

“Sales Transaction information may contain but is not limited to the associated merchant that the purchase was made from, product information including Manufacturer ID, UPC Code, Merchant Code, Merchant Product Code, Product Description, Quantity, Unit Prices, and Order Totals including shipping and handling and taxes. All typical information that is associated with an online order is provided and stored with the transaction.” (Appellant’s Application, Page 11, Paragraph 6)

Nowhere in Gillin, not in the database descriptions of Column 15, line 15 to Column 17, line 9, nor Figures 6A, 6A-1, 6A-2, 6B-1, 6B-2, 6B-3, 7A, 7A-1, 7A-2 and 7B pointed to by the Examiner, is it suggested that such data be recorded. All references to “shoppers”, “shopping baskets” and “transactions” refer to purchase of transfer instruments (temporary credit card accounts), not to what a recipient of such an account purchases with the credit card.

With regards to method Claims 29 - 34, these claims are directed to use with the system and methods disclosed in Applicant’s specification. There is no disclosure in Gillin of the elements of gift certificates or an online gift certificate service as described in Appellant’s application. In Appellant’s specification, “the on-line gift certificate service” is defined as another term used for the Gift Certificate Authority Site of Applicant’s Figure 1. Appellant has already shown that this

element is missing from Gillin. (Appellant respectfully requests the Board to review the definitions within the Appellant's application for these elements cited in the above discussion, which will not be cited again here.) By contrast, the sections of Gillin cited by the Examiner for each step do not apply, because they are all directed to the purchase and use of a temporary credit card from a "reseller" of credit cards issued by credit card issuing banks. In Gillin, no gift certificate is purchased, no online gift certificate service exists, and, therefore, the steps cannot be mapped to disclosures in Gillin.

Since the systems of Appellant and Gillin are based upon completely different base claim elements as outlined above, the system of Gillin cannot possibly perform with the degree of flexibility and control built into Appellant's system. To further illuminate the inherent differences between Applicant's system and methods and those taught by Gillin, attention is directed to the example in Gillin described in Column 23, Lines 45 -55, which the Examiner cites again and again. The only restrictions that can be placed on usage of the credit card in Gillin's example are those that can be placed on any credit card, a beginning and ending date and that the credit card has a total \$500 limit. Gillin's system, totally reliant on credit card banking systems, is simply unable to restrict use of the card beyond that.

In contrast, Applicant's system and methods are capable of vastly more control and flexibility. Consider in Applicant's Claim 31:

"...the user associates a restriction on certificate use, the restriction selected from the group of restrictions consisting of restriction on certificate use by category of product or service, restriction on certificate use by age range of product or service, restriction on certificate use by dollar limitations on a per order or per item basis, restriction on certificate use by date of use range, and restriction on certificate use to use at selected merchant sites."

One benefit of the claimed direct relationship to merchants with the online gift certificate service or Gift Certificate Authority Site, as explained in Applicant's specification, is that while a gift certificate overseen by the Gift Certificate Authority Site of Appellant's application may be for a large amount, the purchaser can specify that no more than \$50 be spent with any one order or with any one merchant (a means of imposing, "Don't spend it all in one place."). Additionally, types of merchants can be eliminated from Applicant's system, such as sellers of pornography, or a gift

certificate purchaser may merely specify a certain merchant (an educational toy store, for example). In contrast, Gillin's temporary credit cards can be used by the recipient as any credit card might with every merchant that accepts them. A purchaser of the temporary credit card has no control over how or where or how much is spent at any one time. The total card limit can be used all at once. If the purchaser's niece wants to make a \$500 purchase at the porn shop, too bad. This is freely admitted in Gillin:

“...the purchaser 236 may have the further option of recommending a particular merchant...however, the recipient need not use the transfer instrument with the merchant(s) recommended.” (Gillin Col. 18, Ln.44-52)

Regarding Claims 35 - 37, the Examiner says that Gillin teaches a recipient and a gift certificate site, and that the beneficiary site and contribution authority site of Claim 35 are not patentably distinct from those elements in Gillin. (Examiner did not indicate any specific sections of Gillin where such claim elements appear, but directed the Board to merely consider the arguments directed to Claim 1.) Gillin does not teach a gift certificate site, nor a gift certificate recipient as defined in Applicant's specification. This has been discussed above. Just as there was no disclosure in Gillin that corresponded with the Gift Certificate Authority Site directly interacting with gift certificate purchasers, gift certificate recipients and the merchants they patronize and, additionally, the Gift Certificate Authority Site hosting merchant databases and itemized merchant transaction databases, there are likewise no disclosures in any of the cited sections of Gillin that correspond to a contribution authority site with the connection to individual beneficiaries, with beneficiary data stored in beneficiary databases. A “contribution authority site which periodically processes payments to beneficiaries from contribution accounts” (Appellant's application, Page 16, Paragraph 6 and Figure 11) is nowhere taught in Gillin.

With regard to the Examiner's allegations about the dependent claims and his rejections of them, Appellant respectfully reminds the Board that every claim is to be examined in light of all of its elements, which for dependent claims includes all of the elements of the base and intervening claims. It is not a sufficient ground for rejection of a claim to allege a correspondence in a reference to only one or two elements of a multi-element claim. All dependent claims stand on their own, but

include all the elements of the base and intervening claims, and, as such, are novel over all cited references.

Applicant clearly claims a system distinct from any online credit card sales schemes. “One significant benefit of the above-described approach is that the Merchants need not be concerned with credit card fraud as their financial dealings are with the Gift Certificate Site rather than the gift certificate users.” (Appellant’s application, Page 4, Paragraph 5) It is equally clear that Gillin discloses a system reliant on existing credit card issuing banking system, which even Gillin considers distinct from a gift certificate, “...unlike with the issuer of conventional gift certificates or gift checks, the issuer operating in accordance with the invention does not need to establish any form of relationship with merchants...”([emphasis added] Gillin, Col. 5, Ln. 54-57). The Examiner has made no attempt to address this distinction in response to the original brief or in response to the revised supplemental brief following the reopening of examination. Gillin’s charge card accounts do not disclose or teach Appellant’s gift certificate service system and methods, nor Appellant’s contribution brokering service. In fact, the Gillin reference actually teaches away from the elements of the claims on appeal.

Therefore none of the appealed claims are anticipated by Gillin, and Applicant requests that all of the Examiner’s rejections be reversed by the Board.

The claims on appeal are again set forth in the attached Appendix.

Respectfully submitted,



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CLAIMS APPENDIX 37 CFR 41.37 (c)(1)(viii)

Claims on Appeal:

1-22. Cancelled.

23. A system for providing an electronic gift certificate service for users over a distributed network, comprising:

 a plurality of merchant sites connected to the distributed network, each merchant site running at least one application to provide an online service to users over the distributed network;

 a plurality of user computers connected to the distributed network, each user computer running at least one application to access the online service at a merchant site;

 a gift certificate authority site connected to the plurality of merchant sites, the gift certificate site including a user database and a merchant database, each database containing authentication information as to respective users and merchants, and a gift certificate database which stores gift certificate data and transaction data related to particular gift certificates, the users accessing the merchant sites from the user computers over the distributed network; and

 an authentication protocol for allowing the gift certificate site to authenticate users and merchants;

 whereby a user purchases a gift certificate having a unique gift certificate identification code on the gift certificate authority site for use at a merchant site, and a merchant site processes the gift certificate through the gift certificate database on the gift certificate authority site.

24. The system of claim 23, further comprising, during user purchase of a gift certificate, the user placing restrictions on the use of the gift certificate.

25. The system of claim 23, further comprising tracking use of the gift certificate by the user.

26. The system of claim 25, further comprising a search mechanism operatively associated with the gift certificate database that provides access to the user to those sales transactions associated with a particular user gift certificate.

27. The system of claim 23, further comprising user anonymity that is effected by preventing merchant site access to any user related data, other than the gift certificate identification code.

28. The system of claim 23, further comprising, within the gift certificate database, and in conjunction with merchant site processing of the gift certificate through the gift certificate database, splitting of the gift certificate across multiple purchases at a plurality of merchant sites.

29. A method for a user to purchase a gift certificate from an on-line gift certificate service, the method comprising the steps of:

user enters a desired dollar amount to be applied to the gift certificate;

user enters a user-selected personal identification number (PIN) for authentication in a gift certificate redemption process;

user provides payment information to the gift certificate site for purchasing the gift certificate;

gift certificate site validates user payment information; and

user receives an gift certificate order confirmation, including a unique gift certificate identification code.

30. The method of claim 29 further comprising, ahead of the step of gift certificate site validation, the user associates a fixed shipping address with the gift certificate.

31. The method of claim 29 further comprising, ahead of the step of gift certificate site validation, the user associates a restriction on certificate use, the restriction selected from the group of restrictions consisting of restriction on certificate use by category of product or service, restriction on certificate use by age range of product or service, restriction on certificate use by dollar limitations on a per order or per item basis, restriction on certificate use by date of use range, and restriction on certificate use to use at selected merchant sites.

32. The method of claim 31 wherein the restriction on certificate use is a restriction on certificate use by category of product or service.

33. The method of claim 29 further comprising, in the step of gift certificate order confirmation, the user selectively elects either immediate online display of the order confirmation, or later e-mail notification, or both.

34. A method for redeeming a gift certificate from an on-line gift certificate service at a merchant site, the method comprising the steps of:

user elects gift certificate as form of payment for selected goods or services at merchant site; user enters unique gift certificate identification code and user selected PIN; and merchant site communicates over distributed network with gift certificate authority site to authenticate the user gift certificate and complete user purchase of selected goods or services.

35. A system for providing an electronic contribution service for users over a distributed network, comprising:

a plurality of beneficiary sites connected to the distributed network, each beneficiary site running at least one application to provide an online service to users over the distributed network;

a plurality of user computers connected to the distributed network, each user computer running at least one application to access the online service at a beneficiary site;

a contribution authority site connected to the plurality of beneficiary sites, the contribution site including a user database and a beneficiary database, each database containing authentication information as to respective users and beneficiaries, and a contribution database which stores contribution data and transaction data related to particular contributions, the users accessing the beneficiary sites from the user computers over the distributed network; and

an authentication protocol for allowing the contribution site to authenticate users and beneficiaries;

whereby a user makes a contribution having a unique contribution identification code on the contribution authority site for use at a beneficiary site, and a beneficiary site processes the contribution through the contribution database on the contribution authority site.

36. The system of claim 35, further comprising, within the contribution database, and in conjunction with beneficiary site processing of the contribution through the contribution database, the contribution is set up to be selectively one-time or recurring automatic.

37. The system of claim 35, further comprising user anonymity that is effected by preventing beneficiary site access to any user related data, other than the contribution identification code.

EVIDENCE APPENDIX (37 CFR 41.37 (c)(1)(ix))

1. None

RELATED PROCEEDINGS APPENDIX (37 CFR 41.37 (c)(1)(x))

1. None